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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,428	08/30/2000	Brian Berson	1697P	2572
7590	10/21/2004		EXAMINER	
Sawyer Law Group LLP P O Box 51418 Palo Alto, CA 94303			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/651,428	BERSON ET AL.	
	Examiner Cong-Lac Huynh	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 May 2004.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.                                    }

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This action is responsive to communications: the amendment filed 5/14/04 to the application filed on 8/30/00.
2. Claims 1-20 are pending in the case. Claims 1, 9, and 15 are independent claims.
3. The update of the status of the co-pending U.S. application mentioned in the specification is acknowledged.
4. The rejections of claims 1-20 under 35 U.S.C. 102(e) as being anticipated by Nielsen have been withdrawn in view of the amendment.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Pat No. 6,278,465 B1, 8/21/01, filed 6/23/97).

Regarding independent claim 1, Nielsen discloses:

- forming a database of font specifications (col 5, line 53 to col 6, line 27 and figure 5B, #524, #528, figure 5C, #542, #548: the Font Size Preference Database storing Font Sizes which are font specifications shows that such a font database is formed)
- accessing the database when opening documents to ensure usage of proper fonts (**figure 4 and col 5, lines 14-28: querying the Size Preference Database when the user access a URL inherently shows accessing the Size Preference Database for querying, and opening documents when a URL is accessed**)
- accessing the database when saving documents to ensure usage of proper fonts (**figure 5C, #542-550 and col 5, line 53 to col 6, line 2: if the user chooses “Yes” to the question “Do you want the page displayed with the current font size from now on”, then the URL and the preferred size are added to the Font Size Preference Database as a new record if no record exists for this URL or as a change to the existing record if one does exists; adding the URL and the preferred size as new record to the Font Database or adding the URL and the**

preferred size as a change to the existing record if one does exist to the Font Database implies accessing the *Font Database to check the existence of the current font size in the database* and to determine that the URL and the preferred size is a *new record or merely a change*; adding the URL for the page along with the preferred font size to the Font Database so that the page is displayed with *the current font size “from now on”* implies saving the page with the preferred size to use from now on)

Nielsen does not disclose that the font specifications including at least two attributes of a font. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated at least two attributes of a font to the font specification into Nielsen since it was well known in word processing that a font specification basically includes the font style and a font size which are the at least two attributes of a font. The combination of such a font specification with at least two attributes to Nielsen would provide more font characteristics for users to select for a document presentation.

Regarding claim 2, which is dependent on claim 1, Nielsen discloses accessing the database when storing further comprising obtaining a font list for a document being saved, and determining whether font specifications for each font in the font list exist in the database (figure 5C, #548 Ask user if new font size should *be recorded or not in Preference Database* where the database includes a font list for documents; figures 3A, 3C).

Regarding claim 3, which is dependent on claim 2, Nielsen discloses that when the font specifications do exist, the method further comprises retrieving the font specifications for each font from the database (figure 4, #410 URL found in size preference DB?, #430 Display file using the font stored in database: the fact that the system checks to see if the URL found in size preference database and if yes, displays file using the font stored in the database shows that the font specification of said URL in conjunction with the URL is retrieved for displaying file using said font stored in the database; col 5, lines 14-28).

Regarding claim 4, which is dependent on claim 3, Nielsen discloses that when the font specifications do not exist, the method further comprises creating the font specifications for each font (figure 5C, #548 and col 7, lines 45-59: the fact that if the URL does not currently exist in the font size preference database, the user is asked if *the new font size* should be recorded in the Font Size Preference Database shows a creating of the font specification for a new font for a file document).

Regarding claim 5, which is dependent on claim 4, Nielsen discloses writing the font specifications into the document, and saving the document (figure 5C, #542-#554: if the URL is not in the font preference database, then *the new font is recorded* for the document in the preferred font size database; this shows that the preferred font size,

which is the font specifications for the document referred by the URL, is written to the document and saved in the database with the URL).

Regarding claim 6, which is dependent on claim 1, Nielsen discloses accessing the database when opening documents further comprises retrieving font specifications from a document being opened (figure 4; col 5, lines 14-28: “ .. if the URL was found in the Size Preference Database then the requested document is displayed using the preferred font size retrieved from the database ... ” ).

Regarding claim 7, which is dependent on claim 6, Nielsen discloses searching the database to locate each font specified by the font specifications in the document (col 5, lines 14-28: the fact that based on the query, the URL was found in the Size Preference Database shows searching the database is carried out to locate the font specification for the document; “if the URL was not found in the Size Preference Database 410, *then a search (see FIG. 8) is made of the Sub-Site Database ...* ” ).

Regarding claim 8, which is dependent on claim 7, Nielsen discloses retrieving each font located (col 5, lines 14-28: the font for the requested document is retrieved either in the Size Preference Database or the Sub-Site Database).

Claims 9-14, 15-20 are for a system and a computer readable medium of method claims 1-8, and are rejected under the same rationale.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Nielson does not disclose accessing the database when saving documents to ensure usage of proper fonts since the recording feature pointed in Nielsen is for recording fonts, not for recording the document (Remarks, page 8).

Examiner respectfully disagrees.

Nielsen does teach that if the user chooses "Yes" to the question "Do you want *the page displayed with the current font size from now on*", then the *URL and the preferred size are added to the Font Size Preference Database as a new record* if no record exists for this URL or as a *change to the existing record if one does exists* (col 5, line 53 to col 6, line 2, also see the related figure 5C as cited in the previous office action). Adding the URL with the preferred size as *new record to the Font Database* or adding the URL with the preferred size as a change to the existing record if one does exist to the Font Database implies *accessing the Font Database to check the existence of the current font size in the database and to determine that the URL with the preferred size is a new record or merely a change*. Also, adding the URL for the page along with the preferred font size to the Font Database so that *the page is displayed with the current font size "from now on"* implies *saving the page with the preferred size for use from now on*.

Applicants also argue that Nielsen does not disclose that the font specifications including at least two attributes of a font as amended in claims 1, 9, and 15. However, it would have been obvious to one of ordinary skill in the art at the time of the invention, was made to have incorporated that feature into Nielsen since it was well known in word processing that a font specification basically includes the font style and a font size which are the at least two attributes of a font.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kamiguchi et al. (US Pat No. 6,338,003 B1, 1/8/02, filed 1/21/98).

Ristow et al. (US Pat No. 5,754,187, 5/19/98, filed 5/16/94).

Unruh (US Pat No. 6,678,688 B1, 1/13/04, filed 10/26/00).

Cheng (US Pat No. 6,501,475 B1, 12/31/02, filed 10/22/99).

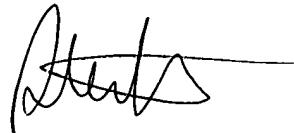
Patel et al. (US Pat No. 6,426,751 B1, 7/30/02, filed 4/1/99).

Gartland (US Pat No. 6,512,531 B1, 1/28/03, filed 4/9/99).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clh  
10/8/04

STEPHEN S. HONG  
PRIMARY EXAMINER